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09/977,777	10/15/2001	Cynthia M. Merkin	16356.662 (DC-03303)	3763
27683 7590 04/06/2007 HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER GLASS, RUSSELL S	
			ART UNIT	PAPER NUMBER
			3626	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/06/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,777	<b>Applicant(s)</b> MERKIN ET AL.	
	<b>Examiner</b> Russell S. Glass	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 1-21 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** In particular, the recent amendments to independent claims 1, 12, and 29 filed on 1/31/2007 contain the indefinite language "and/or".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 1, 2, 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu, (U.S. 5,983,369) in view of Osborn et al., (U.S. 6,182,048).**

Art Unit: 3626

3. As per claim 1, Bakoglu discloses a method of upgrading the warranty of a computer system including a plurality of components in a configuration, the method comprising:

receiving from a requestor a request to upgrade the warranty, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40);

detecting, by the computer system, of a change in the configuration of the computer system, (Bakoglu, Figs. 2, 3, 7, 8, 9; col. 5, line 7-col. 6, line 5; col. 7, line 19-col. 8, line 16; col. 9, lines 5-55; col. 13, lines 13-57)(reading hardware and software configuration properties using interrogation software, software agents and factory-based identifiers is considered to be equivalent to detecting since it performs an identical function in substantially the same way and produces substantially the same results);

sending, by the computer system, of a warranty upgrade request to a remote warranty processor, the warranty upgrade request including configuration information for the computer system, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40) (configuration information in the form of type, revision and serial number are considered equivalent to and obvious in view of configuration information in the form of make, model, year, and VIN number).

determining a price to upgrade the warranty, using factors in the configuration and/or warranty time remaining and/or reliability of components in the configuration and/or age of components in the configuration and/or replacement cost of components in the configuration, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40);

Art Unit: 3626

communicating the price to upgrade the warranty to the requestor, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40); and

sending a warranty authorization to the computer system after acceptance of price to upgrade the warranty, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40).

Osborn fails to disclose a warranty upgrade request for a computer system including configuration information for the components of the computer system. However, it would be obvious to one of ordinary skill in the art to apply the vehicle warranty upgrade and pricing method of Osborn to a computer system because receiving configuration information for the computer system, including information on user field replaceable units (FRU's) in the configuration, such information to be used for a variety of services, including warranties, is well known in the art as evidenced by Bakoglu, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57)(components such as sound cards are considered to be FRU's).

It would be obvious to one of ordinary skill in the art at the time of the invention to configure the interrogation software to invalidate a registered warranty when an unwarranted change in the configuration of the computer system is detected, thus requiring warranty upgrade prior to use. The motivation would be to track and service computer system warranties online, (Bakoglu, Abstract).

Art Unit: 3626

4. As per claim 2, Osborn discloses a method comprising receiving the price to upgrade the warranty, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40).

It would be obvious to one of ordinary skill in the art to combine Osborn and Bakoglu to create a method of upgrading the warranty of a computer system. The motivation would be to track and service computer system warranties online, (Bakoglu, Abstract).

5. As per claim 4, Bakoglu fails to disclose a method further comprising receiving, by the computer system, a warranty authorization including a warranted configuration describing the configuration to be warranted. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

**6. Claims 5, 6, 9, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Olarig et al., (U.S. 6,032,257).**

7. As per claim 5, Bakoglu fails to disclose a method further comprising the computer system receiving the warranty authorization, the warranty authorization

Art Unit: 3626

including a warranted configuration describing the configuration to be warranted.

However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40). The collective system of Osborn and Bakoglu fails to disclose a method further comprising receiving a digitally signed warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Olarig to the collective system of Osborn and Bakoglu. The motivation would have been to prevent warranty fraud, (Olarig, col. 4, lines 57-61).

8. As per claim 8, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes a unique identification number of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig is as provided in the rejection of claim 5 and incorporated herein by reference.

9. As per claim 9, the collective system of Osborn and Bakoglu fails to disclose a method further comprising the computer system authenticating a digitally signed

Art Unit: 3626

warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig is as provided in the rejection of claim 5 and incorporated herein by reference.

10. As per claim 10, the collective system of Osborn and Bakoglu fails to disclose a method further comprising comparing, by the computer system, a warranted configuration in a warranty authorization with the configuration of the computer system, and storing the warranty authorization in secure storage if the warranted configuration matches the configuration of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig is as provided in the rejection of claim 5 and incorporated herein by reference.

11. As per claim 11, the collective system of Osborn and Bakoglu fails to disclose a method wherein a secure processor in the computer system performs the comparing and storing step. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig is as provided in the rejection of claim 5 and incorporated herein by reference.

**12. Claims 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al., (U.S. Pub. 2001/0051884).**

13. As per claim 6, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes warranty type information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn and Bakoglu. The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

14. As per claim 7, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes warranty duration information.

Art Unit: 3626

However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn, Bakoglu, and Wallis is as provided in the rejection of claim 6 and incorporated herein by reference.

**15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu in view of Rajagopalan, (U.S. 6,934,686).**

16. As per claim 3, Backoglu discloses a sending step when a change in configuration is detected, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57).

Backoglu fails to disclose a method of comprising asking, by the computer system, the computer user if a warranty upgrade is desired prior to the sending step when a change in configuration is detected. However, such a prompting method is well-known in the art as evidenced by Rajagopalan, (Rajagopalan, col. 3, lines 20-42; col. 4, lines 13-34; col. 6, lines 27-53). Rajagopalan discloses a method wherein warranties are recommended based upon information obtained by the system. Recommending a different warranty is the equivalent of asking if a warranty upgrade is desired since it performs an identical function in substantially the same way and produces substantially the same results.

It would be obvious to one of ordinary skill in the art at the time of the invention to recommend a warranty as disclosed by Rajagopalan, using configuration information

Art Unit: 3626

obtained as disclosed by Backoglu. The motivation to combine Bakoglu and Rajagopalan would be to create a custom warranty package, (Rajagopalan, col. 1, lines 5-22).

**17. Claims 12, 14, 16, 22-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan.**

18. As per claim 12, Osborn discloses a method of upgrading the warranty including a plurality of components in a configuration, the method comprising:

- (a) receiving, by a warranty processor, of a warranty upgrade request from the computer system, the warranty upgrade request including configuration information, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40); and
- (b) determining, by the warranty processor, of a warranty upgrade price dependent on the configuration information in the warranty upgrade request using factors in the configuration and/or warranty time remaining and/or reliability of components in the configuration and/or age of components in the configuration and/or replacement cost of components in the configuration, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40) (disclosing configuration information in the form of revision and serial number);

communicating the price to upgrade the warranty to the requestor, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40); and

sending a warranty authorization to the computer system after acceptance of price to upgrade the warranty, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40).

Osborn fails to disclose a warranty upgrade request for a computer system, including configuration information for the components of the computer system. However, it would be obvious to one of ordinary skill in the art to apply the vehicle warranty upgrade and pricing method of Osborn to a computer system because receiving configuration information for the computer system, including information on user field replaceable units (FRU's) in the configuration, such information to be used for a variety of services, including warranties, is well known in the art as evidenced by Bakoglu, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57)(components such as sound cards are considered to be FRU's).

The collective system of Osborne and Bakoglu fails to disclose a method of comprising asking, by the computer system, the computer user if a warranty upgrade is desired prior to the sending step when a change in configuration is detected. However, such a prompting method is well-known in the art as evidenced by Rajagopalan. Rajagopalan discloses a method wherein different warranties are recommended based upon information obtained from the computer the system, (Rajagopalan, col. 3, lines 20-42; col. 4, lines 13-34; col. 6, lines 27-53). Recommending a different warranty is the equivalent of asking if a warranty upgrade is desired since it performs an identical function in substantially the same way and produces substantially the same results.

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Rajagopalan to the collective system of Osborn and Backoglu. The motivation to would be to create a custom warranty package, (Rajagopalan, col. 1, lines 5-22).

19. As per claim 14, Bakoglu and Rajagopalan fail to disclose a method further comprising transmitting, by the warranty processor, the warranty upgrade price to the computer system. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

20. As per claim 16, Bakoglu and Rajagopalan fails to disclose a method further comprising generating, by the warranty processor, a warranty authorization including a warranted configuration. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, is as provided in the rejection of claim 12 and incorporated herein by reference.

Art Unit: 3626

21. As per claim 22, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using the replacement cost of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40; col. 5, line 62-64).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

22. As per claim 23, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using a remaining amount of warranty time for a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40, col. 7, lines 32-40)(warranty time measured in days or miles).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

23. As per claim 24, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using age of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col.

Art Unit: 3626

4, line 28-col. 5, line 40)(make, model and year data constitutes age data for a covered component).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

24. As per claim 25, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using reliability data of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40)(historical warranty policy data constitutes reliability data).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

25. Claim 29 contains substantially the same limitations as claim 12 and therefore the reasoning provided in support of the rejection of claim 12 is incorporated herein by reference. A computer system is considered to be a configurable electrical device.

**26. Claims 17, 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan, and further in view of Wallis.**

Art Unit: 3626

27. As per claim 17, the collective system of Osborn, Bakoglu, and Rajagopalan fails to disclose a method wherein the warranty authorization includes warranty type information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn, Bakoglu, and Rajagopalan. The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

28. As per claim 18, the collective system of Osborn, Bakoglu, and Rajagopalan fails to disclose a method wherein the warranty authorization includes warranty duration information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The statement of obviousness and motivation to combine Osborn, Bakoglu, Rajagopalan and Wallis is as provided in the rejection of claim 17 and incorporated herein by reference.

**29. Claim 13, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Olarig.**

30. As per claim 13, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty upgrade request includes a unique identification number corresponding to the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Olarig to the collective system of Osborn, Bakoglu and Rajagopalan. The motivation would have been to prevent warranty fraud, (Olarig, col. 4, lines 57-61).

31. As per claim 19, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes a unique identification number of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig is as provided in the rejection of claim 13 and incorporated herein by reference.

32. As per claim 20, the collective system on Osborn, Bakoglu, and Rajagopalan fails to disclose a method further comprising digitally signing by the warranty processor, the

Art Unit: 3626

warranty authorization to provide a digitally signed warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig is as provided in the rejection of claim 13 and incorporated herein by reference.

33. As per claim 21, the collective system on Osborn, Bakoglu, and Rajagopalan fails to disclose a method further comprising transmitting the digitally signed warranty authorization to the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig is as provided in the rejection of claim 13 and incorporated herein by reference.

**34. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Wallis.**

35. As per claim 15, the collective system of Osborn and Bakoglu fails to disclose a method further comprising receiving payment, by the warranty processor, of the

Art Unit: 3626

warranty upgrade price. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49; claims 6-8).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn, Bakoglu, and Rajagopalan. The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

### ***Response to Arguments***

Applicant's arguments filed 1/31/2007 have been fully considered but they are not persuasive for the following reasons:

1. As per Applicant's argument that the references fail to teach the claimed subject matter, it is submitted that Applicant's arguments with respect to claims 1, 12 and 29 have been considered but are moot in view of the new ground(s) of rejection provided above to these claims.
2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

Art Unit: 3626

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation would be to track and service computer system warranties online, (Bakoglu, Abstract).

3. As per applicant's arguments that the references are not properly combinable because the Osborn patent is from non-analogous art, it is submitted that both Osborn and the current application are located class/subclass 705/4, as well as both being directed to similar subject matter, i.e. product warranties and insurance.

4. As per applicant's argument that the references are not properly combinable because they fail to recognize the problem of inadequate warranty upgrades, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/977,777

Page 21

Art Unit: 3626

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